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09/920,363	08/01/2001	Scot A. Reader		4274

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EXAMINER

MOONEYHAM, JANICE A

ART UNIT	PAPER NUMBER
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3629

DATE MAILED: 06/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/920,363

Applicant(s)

READER, SCOT A.

Examiner

Janice A. Mooneyham

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 01 August 2001 and 15 January 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)                | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                                    |

### **DETAILED ACTION**

1. This is in response to the communication filed on August 1, 2001 and the preliminary amendment filed on January 15, 2002. Claims 1-23 are pending.

#### ***Information Disclosure Statement***

2. The information disclosure statements (IDS) submitted on August 30, 2001 and June 5, 2002 is being considered by the examiner.

#### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 10-11 and 20-23 are rejected under 35 U.S.C. 102(e) as being anticipated by Kossovsky et al (US 2002/0002523) (hereinafter referred to Kossovsky).

Referring to Claims 10 and 20-21:

Kossovsky discloses networking computing system, comprising:

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An end-user station having a user interface (120n) and a network interface (130), wherein the end-user station interacts with the user and the network to determine patent license fee data (see Figure 1 and [0036] and [0039].

Referring to Claim 11:

Kossovsky discloses the network involving a database (Figure 2B) (270) and [0039].

Referring to Claim 22:

Kossovsky discloses an interactive interaction includes a first patent data output on the end-user station followed by a patent data input on the end-user station in response to the first patent data output followed by a second patent data output on the end-user station in response to the patent license input (Online patent and license exchange [0009] - Figure 3 (330) receive bid from buyer, (350) receive bid acceptance from seller, (360) transfer IP license from seller to buyer).

Referring to Claim 23:

Kossovsky discloses the data output includes patent license fee data (Figure 3 (360) and Figure 17 (311 C) Asking price calculated).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the

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prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-9 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Elliott (US 2003/0046105) (hereinafter referred to as Elliott) in view of Hagelin (US 2002/0077835).

Referring to Claims 1 and 17:

Elliott discloses interactive method and program for determining a patent fee, comprising:

inputting on a computer first patent license data ([0077-0078] *In Fig. A at 1A Patent Holder [1] inputs into Computer Program [7] a Patent [2] available for valuation; see also [0022-0023] in order to being the process, a patent estate must be identified*);

processing the first patent license data using a first interaction involving the computer to determine second patent license data ([0028] *determining a value of the Patent Estate using a first valuation algorithm*; [0030] *selecting a second valuation algorithm having at least two inputs* [0032] *entering the value of the patent estate into the second valuation algorithm*);

outputting on the computer the second patent license data ([0036] *entering additional information required by the second valuation algorithm* [0037] *using the second valuation algorithm to determine a change in the current value to the owner of the patent*);

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processing the second patent license data using a second interaction involving the computer to determine third patent license data and outputting the third license data ([0039] *the difference between the two values is the net value of the decision to securitize the patent estate*); and

Elliott does not explicitly disclose a method for calculating a patent license fee or modifying at least part of the second patent license data to produce modified second patent license data and inputting on the computer the modified second patent license data.

However, Hagelin discloses a method for calculating a patent license fee (*calculating the value of a license to a licensor and licensee (abstract)* and [0071] *Figure 7*) and that the basic formula calculates the value of an exclusive license to a given licensor and a given licensee ([0085]. Furthermore, Hagelin discloses the methodology used to calculate the value of non-exclusive license to a given licensor and multiple licensees [0085] (the Examiner interprets the change in licensee and the change in types of licenses as modifications.)

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the license fee of Hagelin with the valuation method of Elliott so that a determination of the competitive advantage of an intellectual property asset can be made and the value of a license for the asset can be determined for both the licensor and the licensee or licensees.

Referring to Claims 2 and 18:

Elliott discloses least one of the first or second interactions involves a database ([0078] *Patent Data is accessed fro patent documents or data*

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*transmitted electronically (facsimile or internet access among other methods); also see [0085] sub-program [21] compares inputs to valuation data array database [40] at 1B which comprises accumulative data).*

Referring to Claim 3:

*Hageling discloses data including patent license fee data ([0085] the basic formula calculates the value of an exclusive license to a given licensor and a given licensee).*

Referring to Claims 4 and 19:

*Elliott discloses the patent license data including a list of affiliated companies ([0023] the patent estate may contain patents owned by third parties so long as the business has exclusive rights in such third parties patents and the right to convey such exclusive rights to others)*

Referring to Claim 5:

*Hagelin discloses the data including global revenue data for a licensee ([0040] the calculations requires information about product's annual gross sales; Figure 4 and [0061] the information that is needed is current annual gross sales).*

Referring to Claim 6:

*Elliott discloses data including licensee's revenues attributable to a technological field (Figure A (19) Technology cost; also see [0140] the output variable TECHVALUE is a current valuation of Patent A as a property asset whose value is the sum of its income contribution due to its technological novelty).*

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Referring to Claim 7:

Elliott discloses data including an exposure rate (*uncertainty risks associated with Patent [0085]*).

Referring to Claim 8:

Elliott disclose the data including a royalty rate (*[0143-0148] a fixed royalty at regular intervals over the remaining life of Patent A in exchange for a license to Company T to practice A, Figure C Royalty Term*).

Referring to Claim 9:

Both Elliott and Hagelin disclose data including a licensee's name (*Elliott/Figure C IP Holder –Licensee and Hagelin/Figure 7 (360)*).

### ***Claim Rejections - 35 USC § 103***

5. Claims 12-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kossovsky as applied to claim 10 above, and further in view of Elliott in view of Hagelin.

Referring to Claim 12:

Elliott discloses the patent license data including a list of affiliated companies (*[0023] the patent estate may contain patents owned by third parties so long as the business has exclusive rights in such third parties patents and the right to convey such exclusive rights to others*)



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Referring to Claim 13:

Hagelin discloses the data including global revenue data for a licensee ([0040] *the calculations requires information about product's annual gross sales; Figure 4 and [0061] the information that is needed is current annual gross sales*).

Referring to Claim 14:

Elliott discloses data including licensee's revenues attributable to a technological field (*Figure A (19) Technology cost; also see [0140] the output variable TECHVALUE is a current valuation of Patent A as a property asset whose value is the sum of its income contribution due to its technological novelty*).

Referring to Claim 15:

Elliott discloses data including an exposure rate (*uncertainty risks associated with Patent [0085]*).

Referring to Claim 16:

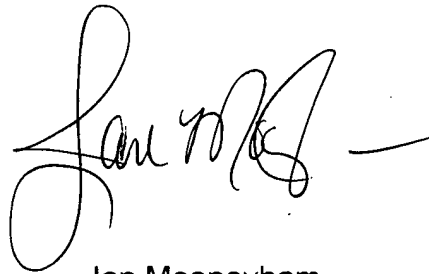
Elliott disclose the data including a royalty rate ([0143-0148] *a fixed royalty at regular intervals over the remaining life of Patent A in exchange for a license to Company T to practice A, Figure C Royalty Term*).

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Janice A. Mooneyham whose telephone number is (571) 272-6805. The examiner can normally be reached on Monday through Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-6812. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read "Jan Mooneyham", followed by a horizontal line.

Jan Mooneyham  
Patent Examiner  
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